



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,397	04/20/2000	Richard R. Reisman	2222.4310009	4230

26111 7590 02/22/2008
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

NGUYEN, TANH Q

ART UNIT	PAPER NUMBER
----------	--------------

2182

MAIL DATE	DELIVERY MODE
-----------	---------------

02/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/553,397

Applicant(s)

REISMAN, RICHARD R.

Examiner

TANH Q. NGUYEN

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-26, 28-35, 37 and 39-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-26, 28-35, 37 and 39-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/09/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) filed August 9, 2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because applicant states that "However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated" - see second paragraph of the front page of the IDS. Such statement suggests that the dates may not be valid, and therefore does not comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this IDS or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).
2. The examiner further notes that numerous references listed on the information disclosure statement (IDS) filed August 9, 2007 were previously considered by the examiner. Applicant needs to submit IDS listing only references not previously considered or not previously cited by the examiner. A submission of IDS that includes references previously considered or cited would increase the burden of examination because the examiner has to find out which of the references not to consider, or inadvertently **consider** the previously considered or cited references **again**.

3. Furthermore, the extraordinary large number of references cited in the information disclosure statement (IDS) filed August 9, 2007 is clouding the issue of patentability of the outstanding claims in the current application. Since applicant states "Listed on accompanying IDS Forms are documents that may be considered material to the examination of this application", applicant essentially suggests that the documents are not necessarily material to the examination of the current application - see first paragraph of the front page. Furthermore, it is not likely that all the references submitted are material to the claims of the present application. **The examiner requests that applicant particularly points out the references germane to the claims within the application.**

Note that, per MPEP 2004 (.13), it is desirable to avoid the submission of long lists of documents if it can be avoided. **Eliminate clearly irrelevant and marginally pertinent cumulative information.** If a long list is submitted, **highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance.** See Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), aff'd, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. denied, 414 U.S. 874 (1974). But cf. Molins PLC v. Textron Inc., 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

An applicant's duty of disclosure of material and information is not satisfied by presenting a patent examiner with **"a mountain of largely irrelevant [material] from which he is presumed to have been able, with his expertise and with adequate time, to have found the critical [material]. It ignores the real world conditions under which**

examiners work. " Rohm & Haas Co. v. Crystal Chemical Co., 722 F.2d 1556, 1573 [220 USPQ 289] (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (Emphasis in original). Patent applicant has a duty not just to disclose pertinent prior art references but to make a disclosure in such way as not to **"bury" it within other disclosures of less relevant prior art;** See Golden Valley Microwave Foods Inc. v. Weaver Popcorn Co. Inc., 24 USPQ2d 1801 (N.D. Ind. 1992); Molins PLC v. Textron Inc., 26 USPQ2d 1889, at 1899 (D.Del. 1992); Penn Yan Boats, Inc. v. Sea Lark Boats, Inc. et al., 175 USPQ 260, at 272 (S.D. Fl. 1972).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 16-26, 28-35, 37, 39-50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "receiving at the user station an information object containing a schedule to monitor a broadcast data stream", does not reasonably provide enablement for "receiving at the user station an information object containing a schedule to cause the user station to watch for at least one desired data object in a broadcast data stream". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

or use the invention commensurate in scope with these claims. Note that a schedule alone cannot cause the user station to watch for at least one desired data object in a broadcast data stream.

7. Claims 20-21, 25, 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

"selecting the first one of the plurality of independently operated data sources from a **listing of each of the plurality of independently operated data sources**" - as recited in claims 20-21, 32;

"wherein the method is performed a plurality of consecutive times, wherein **during each time** the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed" - as recited in claim 25; and

Applicant is required to either remove the new matter, or specifically point out in the disclosure the support for the above limitations - in the reply to this Office Action.

8. Claims 16-26, 28-35, 37, 39-50 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements/steps, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements/steps are elements/steps required for the schedule to cause the user station

Art Unit: 2182

to watch for at least one desired data object in a broadcast data stream.

9. Claims 47-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 recites "the logic for capturing and storing" in line 2. Claim 48 recites "the logic for capturing and storing" in line 2. There is insufficient antecedent basis for the respective limitations in the respective claims.

10. The rejections that follow are based on the examiner's best interpretation of the claims.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16-26, 28-35, 37, 39-50 are rejected under 35 U.S.C. 103(a) as obvious over Young (US 4,706,121) in view of Joseph et al. (US 5,819,034).

13. As per claim 1, Young teaches a method for operating a user station [Abstract], comprising:

receiving at the user station an information object containing a schedule [user setting the schedule - Abstract, lines 5-10] to cause the user station to watch for at least

one desired data object in a broadcast data stream [Abstract, lines 10-15];

receiving the broadcast data stream [135, FIG. 2]; and

capturing and storing the at least one desired data object from the received broadcast data stream based on information in a containing information product [schedule information from FM receiver - Abstract, line 4] and on the schedule [Abstract, lines 15-17].

Young does not specifically teach capturing and storing the at least one desired data object identified in the broadcast data stream based on an object identifier contained in the broadcast data stream.

Joseph teaches an object identifier contained in a broadcast data stream to allow for identification of the data in the broadcast data stream in order to multiplex several independent data streams in a single data stream [col. 4, lines 33-39], and capturing and storing at least one desired data object identified in the broadcast data stream based the object identifier contained in the broadcast data stream [col. 4, line 66-col. 5, line 9].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an object identifier contained in a broadcast data stream to allow for identification of the data in the broadcast data stream, as is suggested by Joseph, in order to allow for multiplexing of several independent data streams in a single data stream - hence allowing for capturing and storing at least one desired data object identified in the broadcast data stream based the object identifier contained in the broadcast data stream.

14. As per claims 17-19, Joseph teaches the at least one desired data object being stored in temporary storage at the user station, fetching the at least one desired data object from the temporary storage, preparing the fetched at least one desired data object for use at the user station [col. 5, lines 5-9]. Young teaches recording the selected program on a VCR (Abstract, lines 15-17), hence the at least one desired data object being stored in temporary storage at the user station (video tape for storing the selected program); the selected program being recorded on a VCR (Abstract, lines 15-17), hence fetching the at least one desired data objects from the temporary storage when the videotape is played back on the VCR; a TV receiver [126, FIG. 3] at the user station, the TV receiver being capable of receiving the selected program from the VCR and displaying the selected program on the TV monitor, hence preparing the fetched at least one desired data object for use at the user station.

15. As per claims 20-22, Young teaches selecting a data source from a listing of a plurality of independently operated data sources (HBO, ESPN...) for supplying the selected program (col. 4, lines 14-24; col. 10, line 11-col. 12, line 42), hence the at least one desired data object being supplied by a first one of a plurality of independently operated data sources and selecting the first one of the plurality of independently operated data sources from a listing of each of the plurality of independently operated data sources; an application programming interface [220, FIG. 5; 116, 118, FIG. 3] providing inputs to a CPU [110, FIG. 3] for supplying user selection (col. 7, lines 51-54; col. 9, line 46-col. 10, line 10), hence an application programming interface enabling a software application to select the first one of the plurality of independently operated data

sources; the broadcast data stream being broadcasted by a data source from a plurality of independently operated data sources including HBO, ESPN... (col. 4, lines 14-24) to the subscribers of such data sources, hence the data stream being multicast.

Joseph further teaches the at least one desired data object being received from (or supplied by) a first one of a plurality of independently operated data sources [channel sources 108, 108A - FIG. 2; col. 9, lines 43-51] and selecting the first one of the plurality of independently operated data sources from the plurality of independently operated data sources [col. 12, line 66-col. 13, line 2; col. 4, lines 54-56], and an application programming interface enabling a software application to select the first one of the plurality of independently operated data sources [col. 12, lines 56-65]. Joseph does not specifically teach selecting a first one of the plurality of independently operated data sources from a listing of the plurality of independently operated data sources. Since it was known at the time the invention was made to list a plurality of independently operated data sources to make it easier for a user to select an independently operated data source, it would have been obvious to one of ordinary skill in the art at the time the invention was made to do so, in order to facilitate the selection by the user.

Joseph does not teach the broadcast data stream being broadcast by Internet multicasting. Since applicant discloses the broadcast information distribution system being an alternative to modem-based wireline or wireless calling to a server; and on the Internet, such broadcasting to a selected group of recipients is called multicasting (page 38, lines 22-27), the use of a broadcast information distribution system or Internet multicasting is not significant, and it would have been obvious to one of ordinary skill in

the art at the time the invention was made to use Internet multicasting in order to practice the Joseph's invention in an Internet environment.

It was known in the art at the time the invention was made for information from the Internet being multicast to subscribers via a router/distributor in order to constantly receive the information without incurring telephone connection costs. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such teachings into Joseph, in order to avoid incurring telephone connection costs.

16. As per claims 23-26, Joseph teaches tuning the user station to receive the broadcast data stream [col. 4, lines 54-56]; the at least one desired data object comprising data to which a user at the user station is entitled [entitlement with a cable system [col. 2, line 26; col. 7, line 9]; the method being performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed [col. 5, lines 32-44]; a user at the user station selecting the at least one desired data object to be captured and stored [col. 12, lines 56-65].

Young teaches the claimed invention except for the method being performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have been previously been captured and stored during a prior time the method is performed; or except for the user station enabling a user to access the captured and stored desired data object while the

user station receives, captures and stores additional desired data objects. In essence, Young's VCR does not allow for receiving, capturing and recording additional desired data objects while enabling the user to play back desired data objects that have been previously been captured and stored. Young, however, teaches recording of selected programs with a recording device that is other than a VCR (col. 3, lines 53-56). It was known in the art at the time the invention was made for a recording device that allows for additional desired data objects to be received, captured and stored while enabling the user to play back desired data objects that have been previously been captured and stored. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such recording device into Young's method since Young teaches the use of a recording device that is other than a VCR and since the incorporation of such device would allow Young's method to be performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have been previously been captured and stored during a prior time the method is performed. The combination would, likewise, allow the user station to enable the user to access the captured and stored desired data objects while the user station receives, captures and stores additional desired data objects.

Young teaches tuning the user station to receive the broadcast data stream (col. 4, lines 48-52; Abstract, lines 10-17); the broadcast data stream being broadcasted by a data source from a plurality of independently operated data sources including HBO, ESPN... (col. 4, lines 14-24) to the subscribers of such data sources, hence the at least

one desired data object comprising data to which a user at the user station is entitled; the user at the user station selecting the at least one desired data object to be captured and stored (col. 7, lines 51-54).

17. As per claims 28-35, 37, the claims generally correspond to claims 16-26 and are rejected on the same bases.

18. As per claims 39-42, 45-46, Joseph teaches capturing and storing the desired data object according to the schedule (see rejection of claim 16 above) and the method being performed a plurality of times (see rejection of claim 25 above), hence repeating the capturing and storing according to the schedule; an updated version of the desired data object [col. 7, lines 25-28]; and optionally purging prior versions of the desired data object by a user [col. 13, lines 37-42].

19. As per claims 43-44, Joseph teaches a method for operating a user station [20, FIG. 1], comprising:

receiving information to cause the user station to watch for at least one desired data object in a broadcast data stream [col. 12, lines 56-65], the broadcast data stream including the at least one desired data object and the at least one desired data object being identified in the broadcast data stream by an object identifier (packet identification information) contained in the broadcast data stream [col. 4, lines 33-39];

receiving the broadcast data stream [via high speed data link 30, FIG. 1], and capturing and storing the at least one desired data object from the received broadcast data stream based on said information, the at least one desired data object's object identifier contained in the broadcast data stream [col. 4, line 66-col. 5, line 9].

Joseph further teaches repeating the capturing and storing (see rejection of claim 25 above), an updated version of the desired object (see rejection of claim 40 above), and optionally purging prior versions of the desired data object by a user (see rejection of claims 41-42 above).

Joseph also teaches the method including broadcasting a home shopping show [col. 8, lines 22-25]. Since it was known in the art at the time the invention was made for a home shopping show to be scheduled as shown on a TV Guide, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a TV Guide to determine when the home shopping show is on to shop, hence capturing and storing the desired data object in accordance with the schedule of the home shopping show.

Furthermore, since it was known in the art at the time the invention was made to use a revised TV Guide to determine when a show is on, hence fetching a revised schedule to determine when the home shopping show is on in order to shop in accordance with the revised schedule for the home shopping show. Note further that it was known to fetch a TV guide from a broadcast data stream.

20. As per claims 47-48, Joseph teaches optionally purging prior versions of the desired data object by a user [col. 13, lines 37-42].

21. As per claims 49-50, the claims generally correspond to claims 43-44 and are rejected on the same bases.

Response to Arguments

22. Applicant's arguments with respect to the 112 rejections have been fully considered but they are not persuasive for all the 112 rejections, and are also moot in view of the new ground(s) of 112 rejections that are necessitated by applicant's amendment.

With respect to claims 20-21, 32 - page 8, line 10-13 merely supports a plurality of independently operated data sources and selection of one of the data sources; page 46, lines 10-14 (the examiner believes that page 46, lines 21-23 is incorrectly cited) merely supports a plurality of independently operated data sources, and user menu selection. There is no indication that the user menu selection is for selection of one of the data sources, and there is no indication that the menu provides a list of each of the plurality of independently operated data sources.

With respect to claim 25 - page 45, lines 19-21 merely supports the method being performed a plurality of times; page 39, lines 7-8 merely supports a user at the user station being able to access desired data objects that have previously been captured and stored during a prior time the method is performed. There is no indication that a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed **during each time** the method is performed.

With respect to claims 47-48, applicant incorrectly suggests that claims 47-48 depend on claim 28. Claims 47-48 depend on claim 44, which depends on claim 16.

23. Applicant's arguments with respect to the art rejections have been considered but

are moot in view of the new ground(s) of rejection.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TANH Q. NGUYEN** whose telephone number is (571)272-4154. The examiner can normally be reached on M-F 9:30AM-7:00PM.

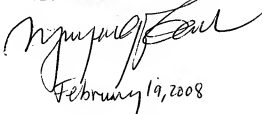
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alford Kindred can be reached on 571-272-4037. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Art Unit: 2182

Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TANH Q NGUYEN
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100



February 19, 2008

TQN
February 19, 2008